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MAILED
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OFFICE OF PETITIONS

In re Patent No. 6,577,403	:	
Issued: June 10, 2003	:	DECISION ON PETITION
Application No. 09/592,963	:	
Filed: June 13, 2000	:	
Attorney Docket No. 19133	:	

This is a decision on the "PETITION TO REVIVE-UNAVOIDABLE", filed April 19, 2012, which is being treated as a petition under 37 CFR 1.378(b) to accept the unavoidably delayed payment of the maintenance fee due at 3.5 and 7.5 years for the above-identified patent.

The petition is **dismissed**.

If reconsideration of this decision is desired, a petition for reconsideration under 37 CFR 1.378(e) must be filed within TWO (2) MONTHS from the mail date of this decision. No extension of this two-month time limit can be granted under 37 CFR 1.136(a) or (b). Any such petition for reconsideration must be accompanied by the petition fee of \$400.00 as set forth in 37 CFR 1.17(f). The petition for reconsideration should include an exhaustive attempt to provide the lacking item(s) noted below because the Director will not undertake any further reconsideration or review of the matter after a decision on the petition for reconsideration.

The patent issued June 10, 2003. The first maintenance fee could have been paid during the period from Monday, June 12, 2006 through Monday, December 11, 2006, or with a surcharge during the period from Tuesday, December 12, 2006 through Monday, June 11, 2007. Accordingly, this patent expired on June 11, 2007, for failure to timely remit the first maintenance fee.

Petitioner, ONERA (Office National d'Etudes et de Recherches Aerospatiales), owner of the patent, asserts reasonable care was taken to ensure that the timely payment of the first and second maintenance fees; however, the delay in payment of the maintenance fee was unavoidable delay. In support of the petition, petitioner provided the Declarations of Roland Lapoux and Sandrine Hamour of the firm of MARTINET & LAPOUX of

Paris, France, which was responsible for the payment of the first maintenance fee, Daniel David of the firm of GEVERS FRANCE, of Paris, France, and Anne Hottat, of GEVERS RENEWALS of Diegem, Belgium, a branch of GEVERS FRANCE, which was responsible for payment of the second maintenance fee. Petitioner avers that “it made timely transfers of the appropriate funds to its French representatives for the proper payments of the first and second maintenance fees, and that, as a consequence of a series of inadvertent administrative errors, its French representatives failed to effect the actual transfer of these funds to the U.S. Patent and Trademark Office.” *Petition, 04/18/12, p. 2*. Petitioner contends that it has been its intention to maintain the patent.

Petitioner set forth the following facts regarding the unavoidable delay in timely paying the maintenance fees as follows:

(1) First Maintenance Fee

(a) On June 28, 2006, prior to the December 10, 2006, first maintenance fee payment deadline, the firm of MARTINET & LAPOUX, of Paris, France, sent Petitioner a notice of maintenance fees due in October, November and December, 2006 (Exhibit 1).

(b) On October 23, 2006, MARTINET & LAPOUX, sent its bill to Petitioner in the amount of 1639.27 Euros (Exhibit 2), covering the cost of the first maintenance fee. This invoice confirmed that Petitioner had authorized payment on July 7, 2006. Normally, this invoice would have been generated after MARTINET & LAPOUX had received a bill from DENNEMEYER & CO. of Luxembourg, following transmittal of the maintenance fee to the U.S. Patent and Trademark Office. (Hamour Statement, Paragraph 4)

(c) On November 13, 2006, MARTINET & LAPOUX entered in its accounting records the receipt of 1639.27 Euros from Petitioner (Exhibit 11). This sum appeared as a deposit on the bank statement of MARTINET & LAPOUX of November 10, 2006 (Exhibit 12), as a credit on the MARTINET & LAPOUX accounting records on January 30, 2007 (Exhibit 13), and as a debit on the MARTINET & LAPOUX Journal on April 6, 2007 (Exhibit 14).

(d) Ms. Sandrine Hamour declares:

“I do not remember to point out any mistake or anomaly in the ONERA account and the Dennemeyer account for 2006.” (Hamour Statement, Paragraph 6).

(e) Following her recent review, Ms. Henriette Buillas reported on January 29, 2012, that “Dennemeyer did not receive Martinet & Lapoux Office instructions between 2006 and 2007 to pay the first maintenance fee. They have this patent in their database since June 13, 2009.” (Exhibit 6)

(f) Mr. Roland Lapoux declares that:

“The default in paying the maintenance fee, i.e., the absence of instruction letter from MARTINET & LAPOUX to DENNEMEYER & Co. and an official statement of payment in the portfolio for December 2006, is incomprehensible and surprising, as the employees responsible for the maintenance fee management invoiced a maintenance fee only after having received a payment instruction confirmation or a payment proof, as an official statement of payment from USPTO from DENNEMEYER & Co.” (Lapoux Statement, Paragraph 15)

“It is also incomprehensible and surprising that the maintenance fee management software (now destroyed) in MARTINET & LAPOUX allowed to maintain in force US patent 6,577,403 and to edit the invoice of October 23, 2006 without probably storing a date of payment of the first maintenance fee.” (Lapoux Statement, Paragraph 16)

(2) Second Maintenance Fee

(a) On April 1, 2008, MARTINET & LAPOUX merged with BLOCH & BONNETAT, which became BLOCH & GEVERS, the French branch of S.A. BUREAU GEVERS. Beginning on July 1, 2008, management of the patent maintenance fees of MARTINET & LAPOUX clients was maintained by GEVERS RENEWALS and BLOCH & GEVERS. (Lapoux Statement, Paragraphs 8 and 9) On February 16, 2009, BLOCH & GEVERS authorized GEVERS RENEWALS to assume responsibility for the payment of maintenance fees for the subject U.S. Patent No. 6,577,403. (Exhibit 3)

(b) On September 2, 2010, GEVERS RENEWALS advised Petitioner that the second maintenance fee was coming due on December 10, 2010 (Exhibit 7). It was the established procedure between Petitioner and GEVERS RENEWALS that if no instructions were received, GEVERS RENEWALS would proceed with payment. (David Statement, Paragraph 3) On November 26, 2010, GEVERS RENEWALS authorized DENNEMEYER & CO. to pay this fee. (Exhibit 8), and on December 7, 2010, DENNEMEYER & CO. presented to GEVERS RENEWALS its invoice in the amount of 1,967.86 for payment of the second maintenance fee, (Exhibit 9), and on December 10, 2010, an invoice to Petitioner was generated by GEVERS RENEWALS in the amount of 2221.00 Euros. (Exhibit 15)

(c) GEVERS RENEWALS then received a credit memo from DENNEMEYER CO. dated December 14, 2020, in the amount of 1942.66 Euro, which included the notation that patent No. 6,577,403 had “expired for non-payment on 06/10/2007.” (Exhibit 10)

(d) The payment by Petitioner of the invoice of December 10, 2010 (Exhibit 15) was received by GEVERS RENEWALS on January 3, 2011. (Hottat Statement, Paragraph 6). Anne Hottat states that:

“I noted that I had to make a credit note to ONERA for the reimbursement of the fee; Due to a temporary heavy burden of work, I decided not to send the letter immediately be the credit note remained untreated and the amount of 1942.86 € was not refunded.” (Hottat Statement, Paragraph 7.)

(e) Daniel David states that:

“The person in charge of the administration of the fees at GEVERS RENEWALS wrongly considered that the patent was voluntarily abandoned and did not investigate further.” (David Statement, Paragraph 7)

(3) Discovery by Petitioner of Patent Expiration

(a) On January 13, 2012, Petitioner sent an E-mail to GEVERS RENEWALS, advising that it had unexpectedly discovered that the U.S. patent No. 6,577,403 had expired following the non-payment of an annuity. This E-mail was acknowledged by Daniel David on January 18, 2016. (Exhibit 4)

(b) The undersigned attorney was contacted about this matter on January 27, 2012, and an opinion was rendered by counsel to client on January 27, 2012.

(c) On March 7, 2012, client authorized counsel to proceed with the preparation and filing of the Petition to Revive, whereupon counsel and client have collaborated in collecting the appropriate Declarations, Exhibits, and English translations, and the transfer of the appropriate funds.

(d) The undersigned attorney states that this petition has been prepared and “filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent.”

Petition, 04/18/12, pp. 2-4

37 CFR 1.378(b) provides that a patent may be reinstated at any time following expiration of the patent for failure to timely pay a maintenance fee. A petition to accept late payment of a maintenance fee, where the delay was unavoidable, must include:

- (A) the required maintenance fee set forth in 37 CFR 1.20(e)-(g);
- (B) the surcharge set forth in 37 CFR 1.20(i)(1); and
- (C) a showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent.

The petition lacks item (3).

The required showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of

the patent, and the steps taken to file the petition promptly. Furthermore, an adequate showing requires a statement by all persons with direct knowledge of the cause of the delay, setting forth the facts as they know them. Copies of all documentary evidence referred to in a statement should be furnished as exhibits to the statement.

As language in 35 U.S.C. 41(c)(1) is identical to that in 35 U.S.C. 133 (i.e., “unavoidable” delay), a late maintenance fee for the unavoidable delay standard is considered under the same standard for reviving an abandoned application under 35 U.S.C. 133. See Ray v. Lehman, 55 F.3d 606, 608-09, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995) (quoting In re Patent No. 4,409,763, 7 USPQ2d 1798, 1800 (Comm’r Pat. 1988), aff’d sub nom., Rydeen v. Quigg, 748 F. Supp. 900, 16 USPQ2d 1876 (D.D.C. 1990), aff’d, 937 F.2d 623 (Fed. Cir. 1991) (table), cert. denied, 502 U.S. 1075 (1992)). See MPEP § 711.03(c) for a general discussion of the “unavoidable” delay standard.

As 35 U.S.C. 41(c) requires the payment of fees at specified intervals to maintain a patent in force, rather than some response to a specific action by the Office under 35 U.S.C. 133, a reasonably prudent person in the exercise of due care and diligence would have taken steps to ensure the timely payment of such maintenance fees. Ray, 55 F.3d at 609, 34 USPQ2d at 1788. That is, an adequate showing that the delay in payment of the maintenance fee at issue was “unavoidable” within the meaning of 35 U.S.C. 41(c) and 37 CFR 1.378(b)(3) requires a showing of the steps taken to ensure the timely payment of the maintenance fees for this patent. Id. Thus, where the record fails to disclose that the patentee took reasonable steps, or discloses that the patentee took no steps, to ensure timely payment of the maintenance fee, 35 U.S.C. 41(c) and 37 CFR 1.378(b)(3) preclude acceptance of the delayed payment of the maintenance fee under 37 CFR 1.378(b).

Acceptance of a late maintenance fee under the unavoidable delay standard is considered under the same standard for reviving an abandoned application under 35 U.S.C. 133. This is a very stringent standard. Decisions on reviving abandoned applications on the basis of “unavoidable” delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word ‘unavoidable’ . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.

In re Mattullath, 38 App. D.C. 497, 514-15 (1912) (quoting Pratt, 1887 Dec. Comm’r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 667-68 (D.D.C. 1963), aff’d, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm’r Pat. 139, 141 (1913). In addition, decisions on revival are made on a “case-by-case basis, taking all the facts

and circumstances into account.” Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was “unavoidable.” Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987). Moreover, patentee’s lack of knowledge of the need to pay the maintenance fee and the failure to receive the Maintenance Fee Reminder do not constitute unavoidable delay. See Patent No. 4,409,763, 7 USPQ2d 1798 (Comm’r Pat. 1988).

As a threshold matter, the Office notes that petitioner has failed to identify the error that was the cause of the delay in timely paying the first maintenance fee, which led to the expiration of the patent. The facts set forth in the petition show that petitioner paid MARTINET & LAPOUX 1,639.27 Euros to cover the cost of the first maintenance fee. However, it is unclear from the statements and documentary evidence presented on petition if the cause of the delay in timely paying the first maintenance fee was (1) the failure of MARTINET & LAPOUX to provide timely instruction to DENNEMEYER to pay the first maintenance fee for the subject patent or (2) the failure of DENNEMEYER to timely remit the maintenance fee to the USPTO upon receipt of the instructions from MARTINET & LAPOUX. Additionally, petitioner did not explain any breakdowns in the business routines of MARTINET & LAPOUX and/or DENNEMEYER, which could explain the reason why DENNEMEYER did not receive the instructions to pay the maintenance fee or if such instructions were received why payment was not timely made to the USPTO. The Office reminds petitioner that it is petitioner’s burden, not the USPTO, to identify the error that was the cause of the delay at issue based on more than speculation. An adequate showing requires a statement by all persons with direct knowledge of the cause of the delay, setting forth the facts as they know them, as well as copies of all documentary evidence in support of the showing. Petitioner should note that a failure in communication does not constitute unavoidable delay within the meaning of 35 U.S.C. 133. See Kim v. Quigg, 718 F. Supp. 1280, 1282 (E.D. Va. 1989).

In determining whether the delay in paying a maintenance fee was unavoidable, one looks to whether the party responsible for payment of the maintenance fee exercised the due care of a reasonably prudent person. Ray v. Lehman, 55 F.3d 606, 608-609, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995). The patent owner at the time of the expiration of the patent is ultimately the person responsible to ensure the timely payment of the maintenance fees. The patent owner may engage another to track and/or pay the maintenance fees; however, merely engaging another does not relieve the patent owner from his obligation to take appropriate steps to ensure the timely payment of such maintenance fees. See California Medical Prods. v. Tecnol Medical Prods., 921 F. Supp. 1219, 1259 (D. Del. 1995). Moreover, the USPTO must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of an applicant, and an applicant is bound by the consequences of those actions or inactions. Link v. Wabash, 370 U.S. 626, 633-34 (1962); Huston v. Ladner, 973 F.2d 1564, 1567, 23 USPQ2d 1910, 1913 (Fed. Cir. 1992). Specifically, delay caused by the actions or inactions of a voluntarily chosen representative does not constitute unavoidable delay within the meaning of 35 USC 133 or 37 CFR 1.137(a). Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (D. Ind. 1987); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff’d, 143 USPQ 172 (D.C. Cir. 1963) (delay caused by a failure to act by or on behalf of the party in interest at the time the action needs to be taken is binding on the successor in title).

Petitioners did not provide any statements from persons from DENNEMEYER, who have firsthand knowledge of the circumstances surrounding the delay in payment of the maintenance fee. In particular, petitioner did not provide a detailed explanation from DENNEMEYER or copies of their record with regard to the events that transpired that lead to the failure to timely submit payment of the first maintenance fee to the USPTO.

On the other hand, if the delay was caused by a docketing error on the part of an employee, it could possibly result in a finding that a delay in payment was unavoidable if it were shown that reasonable care was exercised in designing and operating the system and that reasonable steps were taken to enter the patent into the system to ensure timely payment of the maintenance fees. A showing of unavoidable delay will (in addition to the above) require: (1) evidence concerning the procedures in place that should have avoided the error resulting in the delay; (2) evidence concerning the training and experience of the persons responsible for the error; and (3) copies of any applicable docketing records to show that the error was in fact the cause of the delay. See MPEP § 711.03(c)(III)(C)(2).

A delay resulting from an error (e.g., a docketing error) on the part of an employee in the performance of a clerical function may provide the basis for a showing of “unavoidable” delay, provided it is shown that:

(A) the error was the cause of the delay at issue;

(B) there was in place a business routine for performing the clerical function that could reasonably be relied upon to avoid errors in its performance; and

(C) the employee was sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon such employee represented the exercise of due care.

See In re Egbers, 6 USPQ2d 1869, 1872 (Comm’r Pat. 1988), rev’d on other grounds sub nom., Theodor Groz & Sohne & Ernst Bechert Nadelfabrik KG v. Quigg, 10 USPQ2d 1787 (D.D.C. 1988); In re Katrapat, 6 USPQ2d 1863, 1867-68 (Comm’r Pat. 1988).

In this instance, petitioner did not show that docketing error was the cause of the delay in the timely payment of the maintenance fee. Petitioners did not identify the employee(s) at MARTINET & LAPOUX and/or DENNEMEYER who committed the error in the performance of his or her clerical duties. Petitioner did not submit documentary evidence establishing that was a business routine in place for performing the clerical function that could be reasonably relied upon to avoid errors in its performance, and that the employee was sufficiently trained such that reliance on the employee was an exercise of due care.

In view of the above, the showing of record is inadequate to establish to the satisfaction of the Director that the delay was unavoidable within the meaning of 37 CFR 1.378(b). Accordingly, the petition is **dismissed**.

Petitioner should note that if this petition is not renewed, or if renewed and not granted, then the maintenance fees and post expiration surcharge are refundable. The \$400.00 petition fee for seeking reconsideration is not refundable. Any request for refund should be in writing to the following address:

Mail Stop 16
Director of the US Patent and Trademark Office
PO Box 1450
Alexandria, VA 22313-1450

A copy of this decision should accompany petitioner's request.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By FAX: (571) 273-8300
 Attn: Office of Petitions

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Correspondence may also be submitted electronically via EFS-Web.

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3211.

/Christina Tartera Donnell/

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